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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/902,361 | 07/10/2001 | Joseph M. Monteleone | 18360/234447 | 8871 |

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EXAMINER

SMITH, JEFFREY A

ART UNIT PAPER NUMBER

3625

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/902,361

Applicant(s)

MONTELEONE ET AL.

Examiner

Jeffrey A. Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-5,8,10-12 and 15-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-5,8,10-12 and 15-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>10/11/05</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 19-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 19-21 are directed solely to applications (viewed as computer programs) per se. Such applications are not embodied in any computer readable medium. See MPEP 2106.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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Claims 31, 2-5, 8, 11, 12, 15, 18, 19-21, 25, 27, 28, 30, and 32-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Southam (U.S. Patent No. 6,594,641 B1) in view of Pauly et al. (U.S. Patent No. 4,958,280).

Southam discloses a method, system, and medium embodying a program for:

receiving a product order (col. 4, lines 22-44);

fulfilling at least a portion of the order (col. 3, line 56-col.4, line 3);

statusing the fulfillment of at least a portion of the order(col. 3, line 56-col.4, line 3);

and shipping the product order using shipping labels generated by statusing (col. 3, line 56-col.4, line 3).

Upon shipping, billing information is provided to the order placing entity (col. 6, lines 20-29).

Southam does not disclose generation of the shipping labels in response to determining that an order fulfillment status indicates the product order has been partially or fully filled.

Pauly et al., in a similar method, system, and medium, teaches that a match of a packing slip bard code (which correspond to the actual fulfillment (see col. 14, lines 1-23)) and the individual packs' bar codes will result in a shipping label (col. 14, lines 38-44).

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It would have been obvious to one of ordinary skill in the art to have provided the method, system and medium of Southam to have included the generation of the shipping labels in response to determining that an order fulfillment status indicates the product order has been partially or fully filled in order to allow for shipping of the order or partial order only upon verification that the order or partial order has actually been fulfilled (col. 14, lines 49-60).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 10, 16, 17, 26 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Southam (U.S. Patent No. 6,594,641 B1) and Pauly et al. (U.S. Patent No. 4,958,280), as applied to claims 34, 15, 25, and 28, and further in view of Kohler et al. (US 2002/0032668 A1).

Southam does not disclose tracking.

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Kohler et al. teaches tracking the progress of an order (pars. [0069-0070]).

It would have been obvious to one of ordinary skill in the art to have provided the combination of Southam and Pauly et al. to have included order tracking in order to facilitate transactions between parties to ensure that the process works smoothly and intuitively (Kohler et al.: par. [0070]).

Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Southam (U.S. Patent No. 6,594,641 B1) in view of Pauly et al. (U.S. Patent No. 4,958,280) and Kohler et al. (US 2002/0032668 A1) .

Southam discloses a method, system, and medium embodying a program for:

receiving a product order (col. 4, lines 22-44);

fulfilling at least a portion of the order (col. 3, line 56-col.4, line 3);

statusing the fulfillment of at least a portion of the order(col. 3, line 56-col.4, line 3);

and shipping the product order using shipping labels generated by statusing (col. 3, line 56-col.4, line 3).

Upon shipping, billing information is provided to the order placing entity (col. 6, lines 20-29).

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Southam does not disclose generation of the shipping labels in response to determining that an order fulfillment status indicates the product order has been partially or fully filled.

Pauly et al., in a similar method, system, and medium, teaches that a match of a packing slip bard code (which correspond to the actual fulfillment (see col. 14, lines 1-23)) and the individual packs' bar codes will result in a shipping label (col. 14, lines 38-44).

It would have been obvious to one of ordinary skill in the art to have provided the method, system and medium of Southam to have included the generation of the shipping labels in response to determining that an order fulfillment status indicates the product order has been partially or fully filled in order to allow for shipping of the order or partial order only upon verification that the order or partial order has actually been fulfilled (col. 14, lines 49-60).

Southam does not disclose tracking.

Kohler et al. teaches tracking the progress of an order (pars. [0069-0070]).

It would have been obvious to one of ordinary skill in the art to have provided the combination of Southam and Pauly et al. to have included order tracking in order to facilitate

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transactions between parties to ensure that the process works smoothly and intuitively (Kohler et al.: par. [0070]).

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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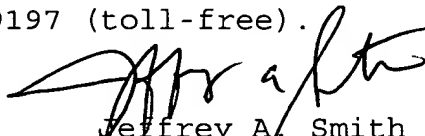
however, will the statutory period for reply expire later than
SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Smith whose telephone number is (571) 272-6763. The examiner can normally be reached on M-F 6:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (571) 272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jeffrey A. Smith
Primary Examiner
Art Unit 3625

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